

U.S. Application No.: 10/635,486
Response to Office Action of October 17, 2007

Attorney Docket No.: FSF-031421

REMARKS

Claim 21 has been amended and claim 22 has been cancelled. These amendments are made to clarify claim terms and ranges and are not made to overcome any prior art rejection. Claims 2, 5-6, 8-11, 13-17, and 19-21 are currently pending.

Claims 2, 5-6, 8-11, 13-17, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, for failing to provide a lower limit for the particle size. The lower limit, as set forth in the specification, has been added to claim 21.

Claims 2, 5-6, 8-11, 13-17, and 19-21 were rejected under 35 U.S.C. 112, second paragraph, for failing to provide antecedent basis for the terms "major axis" and "minor axis." The use of these terms has been clarified. The size distribution has also been clarified by separating the terms so that major axis is divided by the major axis, and the minor axis is divided by the minor axis. This was the meaning of the previous terminology.

Claims 2, 10-11, 13-17, and 19-22 were rejected under 35 U.S.C. 102(e) as being anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as being obvious over U.S. Patent Publication 2003/0235794 to Yoshioka. The portion of the rejection under 35 U.S.C. 102(e) is respectfully traversed.

In making the rejection, the Examiner has stated that "this preparation is related to the claiming of a material by a process. However the material has same of similar composition; and the processing limitation fails to limit the composition of the material." It is respectfully submitted that this identical argument was made during the Pre-Appeal Brief Request for Review. As a result of that Request, prosecution of the present application was reopened. In that Request, Applicants demonstrated that the

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process limitations resulted in a materially different product being formed. The Declaration submitted February 17, 2005 shows that the microstructure of the material made by the claimed process is materially different from the microstructure made by other processes.

Therefore, the reference, at most, can be used to support a rejection based on obviousness. However the reference is assigned to the assignee of the present application.

STATEMENT OF COMMON OWNERSHIP

The present application, U.S. Application Serial No. 10/635,486, and Published Patent Application 2003/0235794 A1 (U.S. Application Serial No. 10/456,629) were, at the time the invention of U.S. Application Serial No. 10/635,486 was made, both owned by FujiFilm Corporation (formerly Fuji Photo Film Co., Ltd.).

Therefore, it is respectfully submitted that the Yoshioka reference is unavailable as prior art under 35 U.S.C. 103(c) and it is requested that this rejection be withdrawn.

Claims 8-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshioka in view of Goto or Farid.

In view of the Statement of Common Ownership set forth above, Yoshioka is unavailable as prior art under 35 U.S.C. 103(c). Therefore, it is respectfully requested that this rejection be withdrawn.

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In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



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